

## REMARKS

Claims 1, 4-10, and 12-18 are pending in this application. Claims 5, 7-9, and 12 are withdrawn from consideration.

The Examiner made the following objection and rejection in the final Office Action mailed March 27, 2007:

- 1) The Examiner alleges the instant CIP application is not entitled to the earliest date in its priority claim.
- 2) The Examiner rejects claims 1, 4, 6, 10 and 13-18 under 35 U.S.C. §103(a) over WO 99/30561 to Warren in view of Holmes (Expert Opinion on Investigational Drugs, 2001), Apelgren *et al.* (Cancer Research, 1990) and U.S. Patent No. 5,997,861 to Virtanen *et al.*

Applicants believe the following remarks traverse the Examiner's rejections. These remarks are presented in the same order as the objection and rejection set out above.

### **1. Applicants Are Entitled To Claim Priority To U.S. Provisional Application**

**Serial No.: 60/390,042**

Applicants respectfully traverse the Examiner's objection to Applicants' priority claim in the Final Office Action mailed March 27, 2007. Section 201.08 of the MPEP states that,

“[u]nless the filing date of the earlier nonprovisional application is actually needed, for example, in the case of an interference or **to overcome a reference**, there is no need for the Office to make a determination as to whether the requirement of 35 U.S.C. 120, that the earlier nonprovisional application discloses the invention of the second application in the manner provided by the first paragraph of 35 U.S.C. 112, is met and whether a substantial portion of all of the earlier nonprovisional application is repeated in the second application in a continuation-in-part situation.” (*emphasis added*)

Turning to the file history in the instant prosecution, the pending claims are not subject to an interference and all the references in the pending art rejection pre-date the earliest priority date claimed<sup>1</sup> by the instant application. That is to say, to date, Applicants have not argued that any

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<sup>1</sup> In paragraph one of the Transmittal Papers filed, on 04/15/04, Applicants distinctly stated the instant application is a continuation-in-part of U.S. Application Serial No.: 10/600,007 filed on 06/18/03 which, in turn, claims priority to U.S. Provisional Application Serial No.: 60/390,042 filed on 06/18/02.

piece of art cited by the Examiner should be disqualified as an art reference because the June 18, 2002 filing date of U.S. provisional application 60/390,042, the earliest filed patent application to which the instant CIP application claims priority, pre-dates the publication date of the cited art.

Given the prosecution history of the instant application provides no basis for inquiry into Applicants' priority claim, as identified by the MPEP, Applicants respectfully request the Examiner's objection be withdrawn.

## 2. The Claims Are Not Obvious

The Examiner maintains the rejection of claims 1, 4, 6, 10 and 13-18, under 35 U.S.C. §103(a), as being allegedly unpatentable over Warren (of record) in view of Holmes (of record), Apelgren et al. (of record) and Virtanen et al. (of record). The Examiner alleges a proper evaluation of obviousness, as set out in Graham v. Deere, has been applied to the pending claims in view of the cited art. Furthermore, the Examiner alleges that Holmes (while silent on aptamers) nonetheless motivates one skilled in the art to produce conjugates comprising aptamers targeted to PSMA (*See*, Office Action dated 03/27/07, p. 3). Applicants disagree.

A *prima facie* case of obviousness requires citation to a combination of references which (a) disclose the elements of the claimed invention, (b) suggests or motivates one of skill in the art to combine the elements to yield the claimed combination, and (c) provides a reasonable expectation of success should the claimed combination be carried out (*See*, MPEP §§2142 and 2143). Importantly, the mere fact that references can be combined is not sufficient, by itself, to establish the desirability or motivation to make the combination (*See*, MPEP §2143.01, citing *In re Mills*, 916 F.2d 680 (Fed. Cir.1990)).

Applicants submit a *prima facie* showing of obviousness has not been established. As discussed in Applicants' Response mailed January 12, 2007, Warren fails to teach, suggest, or make obvious Applicants' claimed embodiments of the present invention. The deficiencies in Holmes' teachings are also detailed in Applicants' last paper. However, the Examiner reasserts this same art by stating,

“[i]t is correct that the Holmes reference is silent with regard to use of aptamers; however, this reference is not relied upon to teach aptamers but is relied upon to provide a motivation why the person of ordinary skill in the art would produce conjugates comprising aptamers targeted to PSMA.” (*See*, Office Action mailed 03/27/07, p. 3).

As a threshold observation, Applicants object to the Examiner's attempt to disclaim<sup>2</sup> the previous statement that,

"[b]ecause aptamers are discovered empirically, the structures of aptamers known from the prior art to target a particular protein would not lead the skilled artisan to the structures of aptamers having the function of binding PSMA." (See, Office Action mailed 07/12/2006, p. 7).

While the Examiner's statement was offered within the context of a rejection under 35 U.S.C. § 112, second paragraph, it was made without disclaimer or qualification. To the extent the Examiner validates, through this statement, the empirical nature of aptamer discovery, Applicants cite it in support of their rebuttal of the Examiner's rejection based on obviousness. If the Examiner admits that non-PSMA binding aptamers, already known in the art, would not inform one skilled in the art as to the structure of a PSMA binding aptamer; then how may a reference (*i.e.*, Holmes) that is completely silent on aptamers motivate one of skill in the art to produce conjugates comprising aptamers targeted to PSMA?

Applicants submit that Holmes only provides motivation to target PSMA with *antibodies* and that the Examiner fails to provide any evidence that would motivate one of skill in the art to combine the teachings of Warren and Holmes. Further, none of the other secondary references (*i.e.*, Apelgren or Virtanen) alone or combined with Warren, teach, suggest, or make obvious the claimed embodiment of the present invention directed to an aptamer-toxin conjugate therapeutic agent comprising a targeting moiety conjugated to a cytotoxic moiety wherein said targeting moiety is an aptamer specific for PSMA.

Applicants, therefore, respectfully request the pending obviousness rejection be withdrawn.

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<sup>2</sup> "It is noted that Applicants' arguments quoting the previously applied written description are moot in view of the [Examiner's] withdrawal of this rejection." (See, Office Action mailed 03/27/07, p.3).

## CONCLUSION

Applicants submit the arguments set forth above traverse the Examiner's rejections and, therefore, request these rejections be withdrawn and the pending claims be passed to allowance. If there are any questions regarding these remarks, or should the Examiner believe a telephone interview would aid in the prosecution of this application, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,

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